

REMARKS

Please note that the claim amendments provided above consist solely of further defining the scope of claimed elements consistent with the specification. These amendments are fully supported by the existing specification and do not result in the introduction of new matter to the specification. Consequently, as no new matter has been added, no new search is required.

This application is believed to be in condition for allowance because the claims, as amended, are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasonings for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject patent application.

1.0 Rejections Under 35 U.S.C. §102(e):

In the Office Action of February 27, 2003, claims 1-10, 12-16, 21-22, 26-37, 39-42, and 45-53 were rejected under 35 U.S.C. §102(b), as being anticipated by Huang et al., U.S. Patent No. 5,996,714 (hereinafter "**Huang**"). A rejection under 35 U.S.C. §102(e) requires that the Applicant's invention was described in patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant. To establish that a patent describes the Applicant's invention, all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the referenced patent, then a rejection under 35 U.S.C. §102(e) is not proper, as the Applicants' invention can be shown to be patentably distinct from the cited reference.

1.1 Rejection of Claims 1, 23 and 29:

The Office Action rejected independent claims 1, 23 and 29 under 35 U.S.C. §102(e) based on the rationale that **Huang** discloses each of the elements of the Applicants claimed "...electronic contact resolution method..." However, in contrast to

the position advanced by the Office Action, the Applicants respectfully suggest that the **Huang** reference does not describe or suggest all of the elements of the Applicants claimed invention.

Specifically, in contrast to the position advanced by the Office Action, it is clear that the **Huang** reference generally describes a mechanism for automatically populating an email address book from sources including sent and received email, email personal address books (PABs), contact databases and other personal information managers (PIMs) that store contact names and numbers. In particular, as described in column 4, lines 5-18, the **Huang** reference describes a system that “involves automatically generating, storing and maintaining a subset of a large address book containing E-mail addresses locally on a client device with limited storage space...” Further, **Huang** also describes a method for automatically generating a default personal address book and keeping a personal address book synchronized with a master database. However, unlike **Huang**, the Applicants describe automatically providing suggested **completion information** automatically generated from contact information for automatically completing partially typed contact entries in direct response to user input.

The Office Action cites column 6, lines 65-67, column 7 lines 45-56, and column 8, lines 61-67 in support of the contention that **Huang** describes a “suggest module capable of generating a set of results dynamically generated and **dynamically generating suggested entries** from the contact information and **related to user entry data**.” However, the Applicants respectfully suggest that the **Huang** reference teaches no such thing.

For example, column 6, lines 65-67 of the **Huang** reference states:

“Additionally, **a user may manually add additional information** (i.e. contents of fields 135 of PAB 128) when new entries are added to PAB 128.” (emphasis added)

Clearly, column 6, lines 65-67 of the **Huang** reference describes manual entry of information. It does **not** describe automatically providing suggested completion information for contact entries in direct response to user input.

Similarly, column 7 lines 45-56 of the **Huang** reference states:

“The additional fields selected in ECCO contain home phone numbers, cellular phone numbers and mail addresses. As entries are found in the ECCO database, they are also copied into PAB 128. Along with each file stored in PAB 128, there is a corresponding identifier 137 that indicates the source of the information contained in that field (MAB 126, PIM, Database, Manual Entry, etc.). The identifier is used later for synchronization of changes back to the source as will be described later. After scanning all known sources of additional information, there may still be empty fields. The user can optionally enter this information manually.”

Note that the acronym “ECCO” in the above cited text refers to a conventional PIM type contact address book provided by NetManage (see column 7, lines 42-44). Clearly, the text cited above simply describes extracting contact information from the ECCO PIM, synchronization of changes to contact information, and optional manual entry of data to fill in empty fields. Again, this cited text clearly fails to describe automatically providing suggested completion information for contact entries in direct response to user input.

Finally, column 8, lines 61-67 of the **Huang** reference states:

“FIG. 3b illustrates the general steps followed in obtaining user settings (step 301 of flow diagram in FIG. 3a). In step 321, additional information sources are selected. The sources may include, but are not limited to, **personal information managers, contact databases, or manual entry.** In step 322, the **user specifies what data fields are to be included** in the device address book.”

Clearly, column 8, lines 61-67 of the **Huang** reference describes the use of personal information managers, contact databases and manual entry for populating a "device address book" in accordance with user specified data fields. Again, **Huang** does **not** describe automatically providing suggested completion information for contact entries in direct response to user input.

In stark contrast, claims 1, 23 and 29 each include an element directed towards dynamically generating suggested address entries from the contact information in response to user data entry. For example, claim 1 recites "*dynamically generating suggested entries from the contact information and related to user entry data...*" Similarly, claim 23 recites "*a set of results dynamically generated from the contact information and related to user data entry...*" Finally, claim 29 recites "*a suggest module capable of generating suggested entries from the contact information that is related to entry data of the user...*" In view of the Applicants specification, and the preamble of the cited claims, it is clear that these cited elements describe automatically providing suggested contact information from a contact database **to complete an address** as soon as the user begins to type an address.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claims 1, 23 and 29, has elements not taught in the **GroupWise** reference. Consequently, the rejection of claims 1, 23 and 29, as amended, under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 1, 23 and 29, and of dependent claims 2-22, 24-28 and 30-32, respectively under 35 U.S.C. §102(e) in view of the above cited novel claim language. *In addition, it should be noted that the claim amendments provided above are not provided in an attempt to overcome the rejection of claims 1, 23 and 29, but rather, to clarify the particular sources of information from which contact information is extracted.*

1.2 Rejection of Claims 2, 25 and 30:

The Office Action rejected dependent claims 2, 25 and 30 under 35 U.S.C. §102(e) based on the rationale that among other things, **Huang** discloses "...data embedded within other electronic application files (column 6, lines 8-24; column 6, lines 65-67; column 7, lines 1-5; column 7, lines 14-24; column 10 lines 1-9)." The Office Action also cites Figure 1e of the **Huang** reference as teaching this claimed element.

As described above, **Huang** describes a system that "involves automatically generating, storing and maintaining a subset of a large address book containing E-mail addresses locally on a client device with limited storage space..." Further, in view of the text cited by the Office Action (column 6, lines 8-24; column 6, lines 65-67; column 7, lines 1-5; column 7, lines 14-24; column 10 lines 1-9), it is clear that **Huang** describes the alternate sources only as personal information managers (PIM), master address books (MAB), and user input through manual entry of data.

Further, unlike the Applicants claimed invention, **Huang** does not describe or suggest searching or scanning other types of electronic files or documents including, for example, word processor files, spreadsheet files, database files, and presentation files, for the purpose of determining whether those files or documents contain contact information including email addresses (see specification, page 11, line 25-27). Note that claims 1, 23 and 29, as amended specifically call out the "other electronic application files" as including "word processor files, spreadsheet files, database files, and presentation files." However, in column 6, lines 15-18, **Huang** expressly describes the type of "electronic files" that are used for extracting contact information as sources "which **include address books**, such as external contact databases or personal information managers (PIMs)" (emphasis added). Further, in addition to failing to mention any use of electronic documents such as word processor files, spreadsheet files, and presentation files, **Huang** fails completely to provide any teaching or suggestion whatsoever for describing how contact information would be extracted from such files.

Consequently, in view of the preceding discussion, it is clear that the present invention, as claimed by dependent claims 2, 25 and 30, has elements not taught in the **Huang** reference. Consequently, the rejection of claims 2, 25 and 30, as amended, under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 2, 25 and 30 under 35 U.S.C. §102(e) in view of the aforementioned novel claim language of claim 2, 25 and 30.

1.3 Rejection of Claims 3, 26 and 31:

The Office Action rejected dependent claims 3, 26 and 31 under 35 U.S.C. §102(e) over the **Huang** reference based on the rationale that **Huang** teaches that “providing ***automatically generated completion information*** comprises providing a ***most probable match from the list to a portion of the user entry.***” (emphasis added)

The Office Action cites column 7, lines 25-35 in support of this contention. However, the cited text states:

“In step 152, MAB 126 is scanned. For illustration purposes, it is assumed that MAB 126 is a corporate E-mail directory. As entries are found that match the cohorts' addresses, additional information in the corporate E-mail directory is copied to PAB 128. For example, the full name of the address is copied, along with the employee ID, mail stop, department, and phone number. For those address entries not found in the corporate E-mail directory (for example, off-site E-mail cohorts and recent new hires), no additional information is added during this stage of the installation procedure.”

Clearly, the cited text is describing searching one or more sources for locating information relating to particular contacts in the users personal address book (PAB), then copying that information and inserting it into the personal address book. The applicants respectfully suggest that the cited text has nothing whatsoever to do with automatically generating completion information in response to user input. In particular,

as discussed above with respect to the rejection of claims 1, 23 and 29, the Applicants are describing and claiming a system wherein as the user begins to type an address, the contact database is searched for potentially matching entries which are then automatically provided as “completion information” thereby enabling the user to select such contact entries without having to type a complete email address. Clearly, this is not what is taught by the **Huang** reference.

Consequently, in view of the preceding discussion, it is clear that the present invention, as claimed by dependent claims 3, 26 and 31, has elements not taught in the **Huang** reference. Consequently, the rejection of claim 3, 26 and 31 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 3, 26 and 31 under 35 U.S.C. §102(e) in view of the novel language of claims 3, 26 and 31.

In particular, claim 3 includes the following novel language:

“providing ***automatically generated completion information*** comprises providing a ***most probable match from the list to a portion of the user entry data.***” (emphasis added)

Similarly, claim 26 includes the following novel language:

“the ***dynamically generated results*** comprises providing a ***most probable match from the entries to a portion of the user entry data.***” (emphasis added)

Similarly, claim 31 includes the following novel language:

“the ***automatically generated completion information*** comprises providing a ***most probable match from the list to a portion of the user entry data.***” (emphasis added)

1.4 Rejection of Claims 22 and 28:

The Office Action rejected dependent claims 22 and 28 under 35 U.S.C. §102(e) over the *Huang* reference based on the rationale that *Huang* teaches that “automatically **suggesting to a user that specific entries from the list be added** to at least one address book and contact database via the user interface.” (emphasis added)

The Office Action cites column 6, lines 30 to 40 and column 7, lines 25-32 in support of this contention. Note that the text of column 7, lines 25-32 are cited and characterized above, while column 6, lines 30 to 40 states:

“Since client device 106 such as SmartPhones have limited storage that may not be able to store the entire PAB 128, two capabilities are used to resolve this problem. First, only selected fields 135 of the additional information for address entries 135 are copied to DAB 132 of client device 106 from PAB 128 (i.e. DABI 130), minimizing the memory used by each address entry 133. Second, PAB 128 is maintained as a ranked list according to address ranking score 139, and only the highest ranked entries (most likely used) are copied into DAB 132 of client device 106.”

Clearly, the cited text is describing searching one or more sources for locating information relating to particular contacts in the users personal address book (PAB), then **automatically** copying that information and inserting it into the personal address book. The applicants respectfully suggest that the cited text has nothing whatsoever to do with automatically **suggesting to a user via a user interface** that a particular contact be added to a personal address book or a contact database. In fact, the processes for populating a personal address book described by *Huang* appears to be completely automatic once the user has defined the desired field and the sources of information to be searched.

Consequently, in view of the preceding discussion, it is clear that the present invention, as claimed by dependent claims 22 and 28, has elements not taught in the

Huang reference. Consequently, the rejection of claim 22 and 28 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 22 and 28 under 35 U.S.C. §102(e) in view of the cited novel language of claims 22 and 28.

2.0 Rejections Under 35 U.S.C. §103(a):

In the Office Action of February 27, 2003, claims 6, 7 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over the **Huang** reference.

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ***to modify the reference*** or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

2.1 Rejection of Claims 6 and 7:

The Office Action rejected dependent claims 6 and 7 under 35 U.S.C. §103(a) based on the rationale that it would have been obvious to one skilled in the art to modify **Huang** to provide for scanning particular files or locations with excluding particular files or locations.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 1, which is the parent claim of claims 6 and 7, **Huang** fails to teach or describe at least one of the elements of the Applicants claimed invention. Consequently, in view of the discussion in Section 1.1, it is clear that modifying **Huang** to provide a capability to scan particular files or locations and to exclude particular files or locations for populating a contact database still fails to teach the underlying automatic completion techniques of the Applicants claimed invention. Consequently, modifying the **Huang** reference to address a particular feature of a dependent claim cannot serve to disclose the applicants claimed invention where the **Huang** reference relied on by the Office Action fails to disclose the parent claim.

Therefore, in view of the preceding discussion, the modification to the **Huang** reference proposed by the Office Action fails to teach at least one claimed limitation of the applicants' invention. Specifically, **Huang** fails to teach "dynamically generating suggested entries from the contact information and related to user entry data" and "providing the suggested entries in the dynamic list via the user interface in real time as the user enters the data" as claimed in claim 1.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claims 6 and 7 under 35 U.S.C. §103(a) over **Huang** in view of the non-obviousness of claim 1, as amended.

2.2 Rejection of Claim 32:

The Office Action rejected dependent claim 32 under 35 U.S.C. §103(a) based on the rationale that it would have been obvious to one skilled in the art to modify **Huang** to provide for the applicants claimed pop-up menu. However, it should be noted the pup-up menu in question provides “suggested entries from the contact information that is related to entry data of the user.” As discussed above in Sections 1.1, 1.2, 1.3 and 1.4, **Huang** does not describe, teach, or in any way suggest providing automatic completion information in response to user data input. Consequently, any menu, pop-up or otherwise that is provided by **Huang** still fails to describe, teach, or in any way suggest providing automatic completion information via a pup-up menu in response to user data input as claimed by the Applicants.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claim is patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 29 and dependent claim 32, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 32 under 35 U.S.C. §103(a) over **Huang** in view of the non-obviousness of claim 29, as amended, and claim 32.



CONCLUSION

In view of the above, it is respectfully submitted that claims 1-32, as amended are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-32 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

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